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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,327	01/17/2004	Kasthuri Venkateswaran	CIT002	8321
28848	7590	10/12/2005	EXAMINER	
TOPE-MCKAY & ASSOCIATES 23852 PACIFIC COAST HIGHWAY #311 MALIBU, CA 90265			TONGUE, LAKIA J	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,327

Applicant(s)

VENKATESWARAN ET AL.

Examiner

Lakia J. Tongue

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



DETAILED ACTION

Applicant's response filed on September 14, 2005 is acknowledged. Claim 1 is pending and under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office Action.

Rejections Withdrawn

1. In view of applicant's response, the rejection under 35 U.S.C. 112 first (page 2) is withdrawn.

Rejections Maintained

2. The rejection of claim 1 under 35 U.S.C. 102(b) is maintained for the reasons of record (page 4).

The rejection was on the grounds that Venkateswaran et al disclosed spore-formers isolated from a spacecraft being that of the genus *Bacillus*. Venkateswaran et al disclose that spores of the bacterial species exhibited resistance to UV, γ -radiation, (H₂O₂) and desiccation. The instant specification characterizes the *Bacillus odysseyi* sp. nov., as round spores that are resistant to Ultra Violet (UV) and gamma radiation, Hydrogen Peroxide (H₂O₂) and desiccation (page 5, section 00035). Aside from the difference in the names of the above strains it is unclear what the differences are between the *Bacillus nealsonii* sp. nov strain, which was isolated from a spacecraft assembly facility and the *Bacillus odysseyi* strain, which was isolated from a spacecraft assembly facility. The organisms appear to be the same microorganisms by a different name.

Applicant urges that a) the cited reference discloses *Bacillus nealsonii*, not *Bacillus odysseyi*, b) the two are very distinct and c) the descriptions of the two species, highlights several distinct differences.

It is the examiner's position that the claims are drawn to an isolated biologically pure culture of *Bacillus odysseyi* strain 34hs-1 under accession number NRRL B-30641. Aside from the difference in the names of the above strains it is unclear what the differences are between the *Bacillus nealsonii* sp. nov strain, which was isolated from a spacecraft assembly facility and the *Bacillus odysseyi* strain, which was isolated from a spacecraft assembly facility. The organisms appear to be the same microorganisms by a different name. While applicant has provided a side-by-side comparison of the two strains, applicant has not given enough information to confirm the difference in the species. The instant specification characterized differences in microorganisms by DNA sequencing, hybridization and 16S rDNA analysis. The evidence that has been provided by way of a side-by-side comparison is not clear because it is not commensurate with what has been done in the specification.

3. The rejection of claim 1 under 35 U.S.C. 102(a) is maintained for the reasons of record (page 5).

The rejection was on the ground that The instant specification describes *Bacillus odysseyi* sp. nov., as round spores that are resistant to Ultra Violet (UV) and gamma radiation, Hydrogen Peroxide (H₂O₂) and desiccation (page 5, section 00035). La Duc et al disclosed the technical description and admission in the priority document 60/440,790, faxed page 1 and 2 of the above strain at an annual conference. LaDuc cited that several spore-forming isolates were found to possess a plethora of resistances, some of which included resistance to g-radiation, UV, H₂O₂, and desiccation (abstract). The strain of the instant application and the strain of the cited prior art have the same properties.

Since the Office does not have the facilities for examining and comparing applicants' composition with the composition of the prior art, the burden is on applicant to show a novel or unobvious difference

Art Unit: 1645

between the claimed product and the prior art. See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

Applicant urges that a) the material presented in the reference covered multiple subjects and was co-authored by four individuals, two of the authors being inventors of the present invention and b) the attached sworn declaration indicates that the present invention was invented at least as early as May 19, 2002 and was diligently pursued with the purpose of its reduction to practice or until the priority filing date of January 17, 2003.

It is the examiner's position that the declaration submitted is not sufficient to overcome this rejection. A declaration of a prior invention must display the showing of facts to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings of records, or photocopies thereof, must accompany and form part of the declaration or their absence satisfactorily explained.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1645

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakia J. Tongue whose telephone number is 571-272-2921. The examiner can normally be reached on Monday-Friday 7-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on 571-272-0864. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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